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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,534	11/20/2003	Robert Farrer Gilmour	4504-1068	6887

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EXAMINER

ALI, SHUMAYA B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/716,534

Applicant(s)

GILMOUR, ROBERT FARRER

Examiner

Shumaya B. Ali

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 18-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 18-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

Response to Amendment

In response to the office action mailed on 9/21/06 the Applicant has cancelled claims 12-17 and entered new claims 21-26. Currently claims 1-11,18-26 are pending in the application.

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 18 contain recitation “free of lace-up elements”, which is considered new matter since applicant’s disclosure is considered to teach lace-up element.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 21-26 provide for the use of the foot and ankle support, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 21-26 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claim 6, “user selected angle” is considered enabling because “strap” according to claim 1 “engage with one side flap and be passed through a corresponding one of the two apertures in the other side flap and returned to the first side flap for engagement therewith”, therefore, the strap seem to have a fixed angle, thus user can not select the angle.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-5,7-11, and 18-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaylord US Patent No. 5,795,316 in view of Montag et al. US Patent No. 5,472,411.

As to claim 1, Gaylord discloses an ankle stabilizer in figures 1-4 with a boot element (12) having an upper part (16) configured to contain a lower part of a user's leg and the user's ankle and a lower part (18) configured to contain at least part of the user's foot (col.6 lines 39-42), the boot element providing a front opening (see fig.2, opening housing tongue 29) and a pair of side flaps (16a, 16b) defining the opening, primary fastening mean (28) operable to draw the side flaps together and each side flap having at least two apertures (26) positioned to form two pairs of adjacent apertures (see fig.2, eyelets are aligned next to each other) when the side flaps are pulled together; **Gaylord however does not disclose primary fastening "means", at least two first straps each first strap able to engage with one side flap and be passed through a corresponding one of the two apertures in the other side flap and returned to the first side flap for engagement therewith, and secondary fastening means to further secure the boot element**, however at the time of the invention these limitation/broadly strapping mechanism was known to one of ordinary skills in the art. Montag et al. who also teaches orthopedic ankle support device in figures 1-6. Montag et al. with side flaps (121,21), two straps (25 and 25') secured to 21, which are able to engage respectively with apertures 126 and 126' on flap 121 and be passed though those apertures and returned to flap 21 (see col.5 lines 65-67 and col.6 lines 1-9). Montag et al. further teaches inner and outer surfaces of each flap having pile thereon of a pile and hook fastening device (125,125'), and the hook being provided on the strap (see col. 6, lines 1-9). Therefore, Montag et al. evidently teaches "at least two first straps" and arrangement of those straps with respect to the side flaps. Therefore, it would have been obvious to one of

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ordinary skills in the art to modify the lacing means of Gaylord in view of Montag et al. hook and pile strapping means for the purposes of providing an alternative means for securing ankle stabilizing device to a user's foot. Gaylord also discloses secondary fastening means (30,32) to further secure the boot element.

As to claim 2, Gaylord discloses wherein the side flaps inherently have inner and outer surfaces (see figures 1-4), however does not disclose **the first strap and the inner and outer surfaces having part fastening means thereon to enable the strap to be secured to the inner surface of one side flap, passed through the aperture in that side flap, looped though the aperture in the other side flap and be secured on the outer surface of the first mentioned flap**, however these limitations are taught by Montag et al. as cited above for claim 1.

As to claim 3, Gaylord discloses wherein a pair of apertures are provided on each side flap, one aperture being at or adjacent the upper part of the boot element and one aperture being at or adjacent the lower part of the boot element (see eyelets 26)

As to claim 4, Gaylord discloses all limitations cited for claim 1 except for **wherein the inner and outer surfaces of each side flap have the pile thereon of a pile and hook fastening device, the hooks being provided on the strap**, however these limitations are considered obvious over the Velcro tape strapping of Monteg et al as cited for claim 1.

As to claim 5, Gaylord discloses secondary fastening means comprises two straps (30,32) having a first end (32a) and a second free end (32b), the first ends being affixed or affixable (see fig.16) to the upper part of the boot element and each of said straps being affixed to extend forwardly and down and having a length to pass across the top of the foot under the metatarsal region (see fig.15) of the foot and diagonally back up to be fastened to the boot

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element (see fig.16), part fastening means being provided on the boot (36a) element and the straps (40) (see col.7 lines 17-52).

As to claim 7, Gaylord discloses a boot element with an upper part and a lower part, and with a first side flap and a second side flap, the upper part shaped to contain a lower part of a user's leg in use including at least the user's ankle, and the lower part shaped to contain at least part of a foot of the user in use as recited for claim 1 above. Gaylord also discloses the boot element, in use, defining a central opening (see fig.4, central opening housing tongue 29) intermediate the first and second side flaps; a tongue (29) bridging the central opening behind the first and second side flaps with edges of the tongue covered by the first and second side flaps (see fig.4). A pair of openings in each of the first and second side flaps (26); a second pair of straps (30,32) affixed to an outer surface of the boot element, the second pair of straps positioned at a point at or adjacent the ankle when the user's foot is contained within the boot element (see col.7 lines 17-52). **Notice, Gaylord discloses first strap 28, Gaylord however does not disclose a first pair of straps threaded through respective ones of the openings to draw the first and second side flaps together.** However at the time of the invention these limitation/broadly strapping mechanism was known to one of ordinary skills in the art. **Montag et al.** who also teaches orthopedic ankle support device in figures 1-6. Montag et al. with side flaps (121,21), two straps (25 and 25') secured to 21, which are able to engage respectively with apertures 126 and 126' on flap 121 and be passed though those apertures and returned to flap 21 (see col.5 lines 65-67 and col.6 lines 1-9). Montag et al. further teaches inner and outer surfaces of each flap having pile thereon of a pile and hook fastening device (125,125'), and the hook being provided on the strap (see col. 6, lines 1-9). Therefore, Montag et al. evidently teaches "at

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least two first straps” and arrangement of those straps with respect to the side flaps. Therefore, it would have been obvious to one of ordinary skills in the art to modify the lacing means of Gaylord in view of Montag et al. hook and pile strapping means for the purposes of providing an alternative means for securing ankle stabilizing device to a user’s foot. Gaylord also discloses secondary fastening means (30,32) to further secure the boot element.

Claims 8, 9, limitations are considered obvious over the teachings Velcro tape/hook and loop type fastener of Montag et al as cited in claim 7. Gaylord discloses limitation of **claim 10** as cited for claim 2, additionally teaches limitation of **claim 11** as cited for claim 3, and further teaches limitation of **claims 18-19** as cited for claims 7-8.

As to claim 20, Gaylord discloses the first and second pair of straps allow the boot element to interchangeably fit both left and right feet ()

As to claim 21, Gaylord discloses wherein at least one of the two pair of adjacent apertures is positioned to be adjacently above the user’s foot, when the support is in use (see fig.2, eyelets of two flaps are aligned and eyelets are seen on the upper and lower part of the boot)

As to claim 22, Gaylord discloses wherein the pair of openings in each of the first and second side flaps defines at least one pair of adjacent apertures positioned to be adjacently above the user’s foot, when the support is in use (see fig.2, eyelets of two flaps are aligned and eyelets are seen on the upper and lower part of the boot).

As to claim 23, Gaylord discloses wherein at least one of the two pairs of adjacent strap openings is positioned to be adjacently above the user’s foot when the support is in use (see

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fig.2, eyelets of two flaps are aligned and eyelets are seen on the upper and lower part of the boot).

As to claim 24, Gaylord discloses wherein when the support is in use, an upper one of the two pairs of adjacent apertures is positioned to be at the user's leg and a lower one of the two pairs of adjacent apertures is positioned adjacent an upper surface of the user's foot (see fig.2, eyelets of two flaps are aligned and eyelets are seen on the upper and lower part of the boot).

As to claim 25, Gaylord discloses wherein when the support is in use, the pair of openings in each of the first and second side flaps defines at least one pair of adjacent apertures positioned adjacent the user's leg and another pair of adjacent apertures positioned at an upper surface of the user's foot (see fig.2, eyelets of two flaps are aligned and eyelets are seen on the upper and lower part of the boot).

As to claim 26, Gaylord discloses wherein when the support is in use, an upper one of the two pairs of adjacent strap openings is positioned to be at the user's leg and a lower one of the two pairs of adjacent strap opening is positioned adjacent an upper surface of user's foot (see fig.2, eyelets of two flaps are aligned and eyelets are seen on the upper and lower part of the boot), the first pair of straps threaded through respective one of the upper strap openings to draw the first and second side flaps together at the user's leg (as taught by Montag et al, see claims 1,18), the second pair of straps drawing the outer surface of the boot element and the second pair of straps across the upper surface of the user's foot (see col.7 lines 17-52).

Drawings

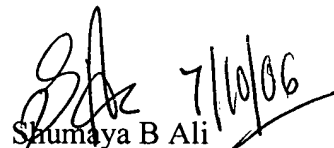
New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Applicant claims limitation disclosed in figure 2 in combination of the limitation of figure 1, however figure 1 discloses one pair of aperture not two pair of apertures as shown in figure 2 and see claims 1 and 5 and no single figure seem to disclose the combined limitations as claimed in claims 1 and 5. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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Art Unit 3743


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